

REMARKS

1        The Examiner asserts that the Information Disclosure Statement filed March 13, 2002, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance of each patent listed that is not in the English language.

5        The foreign language prior art cited by applicant was cited by the examining authority in a PCT application. A translation of the same was not provided to applicant. Further, applicant asserts that he is not under a duty to translate the prior art for the Examiner. Insofar as the applicant is not fluent in the language corresponding to the cited art, applicant cannot explain the relevance of the prior art. Accordingly, applicant requests

10      reconsideration of the Examiner's assertion.

15      The Examiner objected to the drawings under 37 CFR 1.83(a). The Examiner stated that the "tube having an arcuate portion" must be shown or the features cancelled from the claims. The specification, at page 4, lines 13-15, describes that the distal end 24 of the tube 20 is provided with an angular or arcuate portion referred to generally by the reference numeral 26. Further, contrary to the Examiner's objection, the drawings do show an arcuate portion. The tube may be described as having an angular or an arcuate portion depending on what part of the tube is being described. As stated in the Merriam-Webster Dictionary, an arc is defined as a continuous portion of a curved line (as part of the circumference of a circle). As seen in Figure 2 of the present invention, the end portion of the elongated tube clearly depicts an arcuate portion. Accordingly, applicant believes the Examiner's rejection is in error. The Examiner also objected to the drawings under 37 CFR 1.84(p)(5) because the reference sign 33 is not

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1 mentioned in the description. In light of the Examiner's objection, the specification has  
been amended accordingly.

5 The Examiner objected to the Abstract of the Disclosure because it is directed to  
a method of cementing a liner in the glenoid cavity. The Examiner notes that the  
present invention is directed to a tool and, therefore, it should be the focus of the  
Abstract. In view of the Examiner's objection, the Abstract has been amended as set  
forth above.

10 The Examiner objected to claim 7 under 35 U.S.C. § 112, second paragraph, as  
being indefinite for failing to particularly point and distinctly claim the subject matter  
which applicant regards as the invention. Specifically, the Examiner states that there is  
insufficient antecedent basis for the term "said elongated member." As recited above,  
claim 7 has been amended to overcome this objection.

15 The Examiner rejected claims 1, 2 and 4 under 35 U.S.C. § 102(b) as being  
anticipated by Angsupanich (5,197,949). Applicant respectfully disagrees with the  
Examiner for the reason that applicant believes that the Examiner has misconstrued the  
teachings of Angsupanich and the structure recited in claim 1 of the present invention.  
20 Claim 1 recites a tool for insertion through the coracoid process into the glenoid vault of  
a scapula. Claim 1 has been amended to clarify that the tube has a length and  
diameter such that the distal end may be positioned into the glenoid vault and that the  
proximal end may be in communication with a suction mechanism. As claim 1 makes  
clear, the very purpose of the present invention is to allow the user to navigate the tool

1 within the coracoid process in the glenoid vault. Any other interpretation reads  
language out of the claim.

5 Contrary to claim 1 of the present invention, Angsupanich teaches a device for  
removing blood and bodily fluids during a surgery. It is clear from the structure taught in  
Angsupanich that the suction/irrigation device is used for open-flesh surgeries. The  
teachings in Angsupanich indicate that the device cannot be used to navigate a bone  
cavity. As shown in each of the figures, a cross-section of the device increases from its  
distal to its proximal end. This structure would prohibit any device from proficiently  
10 navigating a hole in the bone because the varying cross-section of the device would  
contact the outer edge of the bone cavity. Accordingly, applicant asserts that claim 1 of  
the present invention is not anticipated by Angsupanich.

15 With regard to claims 2 and 4 of the present invention, claims 2 and 4 recite that  
the tube has a plurality of openings and that the tube has an angular portion. Applicant  
asserts that Angsupanich does not teach, disclose or otherwise show the structure of  
claims 2 and 4. Furthermore, inasmuch as claims 2 and 4 ultimately depend from  
independent claim 1, the same are thought to be allowable.

20 The Examiner rejected claims 1, 3 and 6 under 35 U.S.C. § 102(b) as being  
anticipated by Bonutti (5,403,317). Applicant asserts that the Examiner's rejection is in  
error. Claim 1 of the present invention describes a suction tool. The elongated tube of  
the suction tool is specifically described as being rigid. Converse to the specific  
language of claim 1, Bonutti teaches a drill having a flexible shaft. Furthermore, Bonutti  
does not teach, show or otherwise disclose a tool for insertion into a bone in order to

1 implement a suction force. Therefore, applicant believes that claim 1 is clearly  
allowable over the Examiner's cited art.

5 With regard to claim 3 of the present invention, claim 3 describes that the tube  
has an arcuate portion. Regarding claim 6 of the present invention, claim 6 specifically  
recites that the tool includes an elongated sleeve which is slidably mounted on the tube.  
Applicant asserts that Bonutti does not teach these limitations in any manner.  
Specifically regarding claim 6, there is absolutely no teaching in Bonutti that a sleeve is  
slidably mounted. Accordingly, applicant asserts that claims 3 and 6 distinguish the  
Examiner's prior art.

10 The Examiner rejected claims 1-3, 5 and 6 under 35 U.S.C. § 102(b) as being  
anticipated by Lee et al. Lee teaches a catheter for insertion into the flesh of the  
abdomen. Clearly, for the same reasons recited above, Lee does not teach a tool for  
insertion through the coracoid process and into the glenoid vault of the scapula as  
15 specifically described in the claims of the present invention. Furthermore, Lee does not  
teach, disclose or otherwise show a tube having a length and diameter such that its  
distal end may be positioned in the glenoid vault and so that its proximal end may be  
placed in communication with a suction mechanism. Accordingly, applicant asserts that  
claim 1 of the present invention distinguishes Lee.

20 With regard to claims 2-3 and 5-6, applicant asserts that Lee does not teach the  
limitations of those claims. Specifically regarding claim 5 of the present invention, claim  
5 recites that a flexible obturator may be selectively extended through the tube to clear  
the tube of debris. Lee does not teach this structure of claim 5. Lee merely teaches  
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1 that a stiffening means such as a trocar or obturator may be positioned juxtaposed the  
tubular passageway in order to allow for the easy introduction of the catheter into the  
abdomen. Specifically regarding claim 6 of the present invention, there is no teaching in  
Lee that the tool includes an elongated sleeve which is slidably mounted on the tube.  
5 Accordingly, applicant asserts that claims 2-3 and 5-6 are not anticipated by Lee under  
35 U.S.C. § 102(b).

10 The Examiner rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable  
over Angsupanich in view of Pagan (6,019,753). The Examiner concedes that  
Angsupanich does not disclose a sealing means at the distal end of the tube. However,  
15 the Examiner argues that Pagan teaches such a sealing means. Therefore, the  
Examiner contends that it would have been obvious to one of ordinary skill in the art to  
use the sealing means as taught in Pagan with the device of Angsupanich for  
stabilization in order to secure the hollow tube in the surgical area to enable the area to  
20 be fully cleared of debris.

25 Applicant disagrees with the Examiner's argument. The Pagan invention  
pertains to a tracheostomy tube for positioning in a patient's throat. Angsupanich  
pertains to an irrigation suction device for moving blood and other bodily fluids from an  
individual during surgery. There is no suggestion in either of the references that they  
may be combined in the manner suggested by the Examiner. Furthermore, Pagan does  
not teach a sealing means as specifically recited in claim 7 of the present invention.  
Pagan merely teaches a flange for stabilizing the tracheostomy tube within the opening  
on the neck. The flange is not a seal. If this was so, the patient would suffocate.

1 Accordingly, applicant asserts that claim 7 is clearly allowable over the Examiner's cited  
art.

5 In light of the above remarks, applicant also believes that new claim 8 is allowable over the Examiner's rejections. Claim 8 specifically describes a tool for drawing external material into a honeycomb structure of a bone by providing a negative pressure to a bone cavity. Claim 8 continues by reciting that the tool comprises an elongated tube having a distal end positionable within the bone cavity. The elongated tube also has a proximal end that is in operative communication with the suction mechanism. Claim 8 also recites that the tool comprises a sealing means for selectively  
10 sealing the bone cavity while the suction mechanism provides a negative pressure to the bone cavity to thereby draw external material into the honeycomb structure of the bone. Applicant believes that none of the Examiner's cited art teaches the limitations as specifically recited in claim 8.

15 Applicant maintains that the claims are in condition for allowance. Accordingly, applicant respectfully requests reconsideration and allowance of the same.

20 No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 502093.



Respectfully submitted,

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CERTIFICATE OF MAILING

10 I hereby certify that the original of this AMENDMENT for R. MICHAEL GROSS,  
Serial No. 10/046,592, was mailed by first class mail, postage prepaid, to Mail Stop  
Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA  
22313-1450, on this 21 day of July, 2003.

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